

1614
167

Practitioner's Docket

U 013022-9

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Jan Adrianus VERSCHOOR, et al

Serial No.: 09/696,605

Group No.: 1614

Filed: October 25, 2000

Examiner: Kevin E. Weddington

For: COMPOSITION COMPRISING A CARRIER AND A PURIFIED
MYCOBACTERIAL LIPID CELL-WALL COMPONENT AND ITS USE IN THE
PREVENTION, TREATMENT AND DIAGNOSIS OF DISEASE

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

AUG 09 2004

TRANSMITTAL

TECH CENTER 1600/2900

WARNING: Failure to file a complete response in compliance with § 1.135(c) leads to a reduction in patent term adjustment - See § 1.704(c)(7).

1. Transmitted herewith is an amendment for this application.

STATUS

2. The application is qualified as

a small entity.
 other than a small entity.

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10**(When using Express Mail, the Express Mail label number is mandatory;
Express Mail certification is optional.)*

I hereby certify that, on the date shown below, this correspondence is being:

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deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

37 C.F.R. 1.8(a)

37 C.F.R. 1.10*

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TRANSMISSION

transmitted by facsimile to the Patent and Trademark Office, to (703) 872-9306

Date: August 2, 2004

Signature

CLIFFORD J. MASS

(type or print name of person certifying)

Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(j). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

EXTENSION OF TERM

NOTE: "Extension of Time in Patent Cases (Supplement Amendments) — If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of December 10, 1985 (1061 O.G. 34-35).

NOTE: See 37 C.F.R. §1.645 for extensions of time in interference proceedings, and 37 C.F.R. § 1.550(c) for extensions of time in reexamination proceedings.

NOTE: 37 C.F.R. § 1.704(b)"... an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph."

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply.

(complete (a) or (b), as applicable)

(a) Applicant petitions for an extension of time under 37 C.F.R. 1.136
(fees: 37 C.F.R. 1.17(a)(1)-(4)) for the total number of months checked below:

<u>Extension (months)</u>	<u>Fee for other than small entity</u>	<u>Fee for small entity</u>
<input type="checkbox"/> one month	\$ 110.00	\$ 55.00
<input type="checkbox"/> two months	\$ 420.00	\$ 210.00
<input type="checkbox"/> three months	\$ 950.00	\$ 475.00
<input type="checkbox"/> four months	\$ 1,480.00	\$ 740.00
<input type="checkbox"/> five months	\$ 2,010.00	\$ 1,005.00

Fee: \$ _____

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

An extension for _____ months has already been secured. The fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

OR

(b) Applicant believes that no extension of term is required. However, this is a conditional petition being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. 1.16(b)-(d)) has been calculated as shown below:

			SMALL ENTITY			OTHER THAN A SMALL ENTITY		
(Col. 1)	(Col. 2)	(Col. 3)						
Claims Remaining After Amendment	Highest No. Previously Paid For	Present Extra	Rate	Addit. Fee	OR	Rate	Addit. Fee	
Total * Minus **	=	x \$ 9=	\$		x \$ 18=	\$		
Indep. * Minus ***	=	x \$ 43=	\$		x \$ 86=	\$		
<input checked="" type="checkbox"/> First Presentation of Multiple Dependent Claims		+ \$145=	\$		+ \$290=	\$		
		Total Addit. Fee	\$ _____	OR	Total Addit. Fee	\$ _____		

- * If the entry in Col. 1 is less than the entry in Col. 2, write "O" in Col. 3,
- ** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".
- *** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".
- The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

WARNING: *"After final rejection or action (§ 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made." 37 C.F.R. 1.116(a) (emphasis added).*

(complete (c) or (d), as applicable)

(c) No additional fee for claims is required.

OR

(d) Total additional fee for claims required \$ _____

FEE PAYMENT

5. Attached is a check in the sum of \$ _____

Charge Account No. 12-0425 the sum of \$ _____

A duplicate of this transmittal is attached.

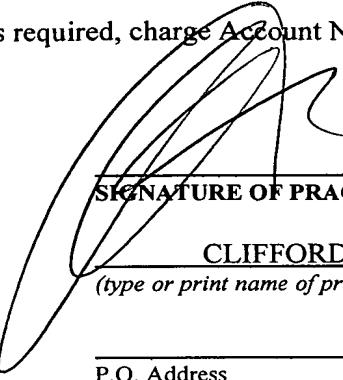
FEE DEFICIENCY

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, (1065 O.G. 31-33).

6. If any additional extension and/or fee is required, charge Account No. 12-0425.

AND/OR

If any additional fee for claims is required, charge Account No. 12-0425


SIGNATURE OF PRACTITIONER

Reg. No. 30,086

CLIFFORD J. MASS

(type or print name of practitioner)

Tel. No. 212-708-1890

P.O. Address

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New York, N.Y. 10023**



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Attorney Docket No.: U 013022-9

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Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION

Applicants respectfully request reconsideration of the Petition Decision of 26 July 2004 denying Applicants' petition for withdrawal of abandonment.

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*

*(When using Express Mail, the Express Mail label number is mandatory;
Express Mail certification is optional.)*

I hereby certify that, on the date shown below, this correspondence is being:

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TRANSMISSION

transmitted by facsimile to the Patent and Trademark Office, to (708) 372-9306

Date: August 2, 2004

Signature

CLIFFORD J. MASS
(type or print name of person certifying)

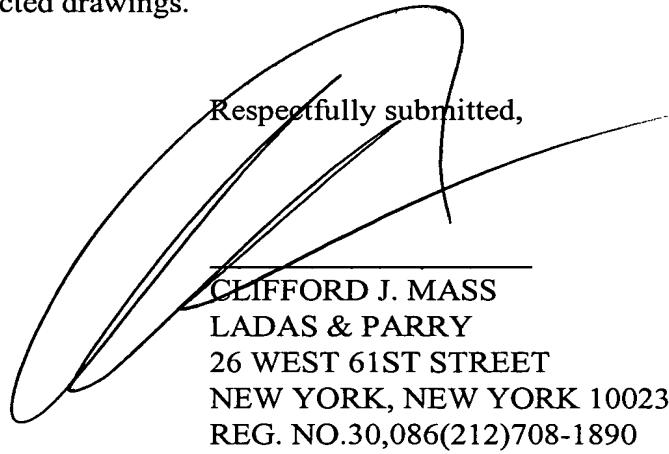
*WARNING: Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. 1.10(b).
"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

The petition was based upon the fact that Applicants received a notice of abandonment after submitting corrected drawings on September 6, 2003 rather than a notification setting a term for submitting new, corrected drawings. The petition was denied because the submission of new drawings on September 6, 2002 allegedly did not reflect a good faith effort to overcome all of the objections to the drawings set forth in PTO Form 948 mailed with the Notice of Allowability. However, the drawings submitted on September 6, 2002 are in all pertinent respects the same drawings that were submitted and accepted in the application that issued as US Patent 6,433,013. It is respectfully submitted that an applicant cannot possibly be considered to have acted in bad faith in the submission of drawings that were found acceptable by the USPTO in an application that actually issued in a US patent. Moreover, the issuance of a patent with the drawings is a *prima facie* indication that the drawings are sufficient (see 35 USC 282).

In addition, if it were considered that the drawings were not submitted in good faith, why were applicants not informed of this with the communication of 18 October 2002. The 18 October communication did not advise that the drawings were not submitted in good faith. To the contrary, the Notice of Draftsperson's Patent Drawing Review included with the communication had the following statement on the front: "The Examiner will require submission of new, corrected drawings when necessary." (Note: the statement on the reverse side- -that new drawings were required within the period remaining in the notice of allowability- -offered no opportunity for correction of the drawings because the three month period for reply in the Notice of Allowability

had already run.) The Petition Decision respectfully fails to address this salient fact: the finding that Applicants' allegedly did not make a good faith effort to overcome the drawing objections by their submission of 6 September 2002 was not made or communicated to Applicants until 22 months after the drawings were submitted.

Based on the above, it is respectfully submitted that the finding that Applicants did not make a good faith effort to overcome the drawing objections is insupportable. The USPTO erred in not setting a term for Applicants to correct any alleged informalities in the drawings submitted September 6, 2002, and in not acting promptly on Applicants petition to withdraw filed July 11, 2003. Applicants respectfully submit that their petition for withdrawal of abandonment should be granted and that the USPTO should, upon withdrawal of the abandonment, set a term within which Applicants may submit corrected drawings.



Respectfully submitted,

CLIFFORD J. MASS
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